

By the present amendment, Applicant submits that the following remarks overcome the objections and rejections as made by the Patent Office and places the application in condition for allowance.

With respect to the rejection of Claims 1-3, 7-9 and 11 under 35 U.S.C. §103(a) as being unpatentable over *Walz*, Applicant respectfully submits that the claims are patentably distinct from *Walz* or any art of the record, taken singly or in combination.

More specifically, Claim 1 defines a special service mailing assembly having a label. The label has a front side and a backside and includes a return postcard integrally formed with a designator section indicative of a special service. The designator section is completely contained within the exterior sides that define the return postcard. The label further includes shading and printing of a single color.

Further, Claim 9 defines a method for preparing a mailpiece for delivery by a special service. The method requires the steps of providing a label and providing at least one anchor portion. The label has a front side and a back side. The label includes a return postcard integrally formed with a designator section indicative of the special service. The designator is contained completely within exterior sides that define the return postcard.

The label also includes shading and printing wherein the shading and printing are a single color. The anchor portion is on an exterior side of the return postcard and the anchor portion has a backside wherein the backside of the anchor portion has an adhesive. The method also requires the steps of removing a backing strip disposed over the adhesive and attaching the label to a mailpiece to effect delivery by the special service.

The Patent Office submits "it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section and postcard, since it would only depend on the intended use of the assembly and the desired information to be displayed." (Office Action dated June 4, 2001, paragraph 7.) Further, the Patent Office submits that "when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability." (See Office Action dated June 4, 2001, paragraph 7.)

Contrary to this assertion by the Patent Office, the designator section as defined by Claims 1 and 9 is integrally formed with the return postcard wherein the designator section is completely within the exterior sides that define a return postcard. This arrangement of the return postcard with the designator section provides at least two forms on a single sheet.

This arrangement allows for the printing of more than one form at a time. For example, a single sheet having two forms may pass through a printer wherein both forms are printed upon such that each form may be used for two different packages. Companies and/or individuals may save time with such an arrangement. Further, companies may save space as more than one form may be provided on a single sheet. Thus, the functional relationship is altered.

The Patent Office provided no teaching as to why one having ordinary skill in the art would have been led to modify the form disclosed by Walz that was applied in the Office Action in the rejection under 35 U.S.C. §103(a) and to modify that form to use the same with information related to the delivery of the article by a special service.

In the Office Action, the Patent Office asserts that the method for preparing a mailpiece for delivery is inherently taught by Walz and the choice of ornamentation (color or shading) produces no mechanical effect or advantage. In response to these assertions, Applicant submits the following arguments:

Walz merely discloses a multi-part mailing form having two superimposed sheets of material wherein detachable areas of the upper sheet are detached and secured to an item to be mailed, and

sections of the sheets are separable from one another. One of the separable sections includes a return postcard.

Nowhere does *Walz* teach a return postcard integrally formed with a designator section indicative of a special service wherein the designator section is completely contained within the exterior sides that define the return postcard. The arrangement of the return postcard with the designator section provides at least two forms on a single sheet.

Further, as defined in Claims 1 and 9, the label of the present invention requires shading and printing of a single color. For example, the color may be green to designate the generally recognized color for certified mail or may be brown to designate the generally recognized color for return receipt for merchandise mail, or the like as was stated in the specification at page 13, lines 29-34. By providing at least two forms on a single sheet and by providing color to the mailing labels to designate a special service, the mailing assembly of the present invention simplifies and expedites the preparation of a mailpiece requiring delivery by a special service. Thus, the mailing assembly as defined by the claims of the present invention is distinct from *Walz*.

Further, the Patent Office states that "it would have been obvious to one having ordinary skill in the art at the time the

invention was made to integrally form the designator portion with the postcard, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art." (See Office Action dated June 4, 2001, page 4, paragraph 2).

Applicant submits, however, that *Walz* discloses two distinct articles (i.e. the return postcard and the designator section) which are not combined to form one piece. Further, as defined by the claims of the present invention, the return postcard and the designator section are NOT just merely "put together". The postcard and the designator section are integrally formed within the return postcard.

As to the rejection of Claims 4 and 12 under 35 U.S.C. §103(a) as being unpatentable over *Walz* in view of *Petkovsek*, Applicant respectfully submits that the claims are allowable over the references of record for the same reasons set forth with respect to their parent Claims 1 and 9, respectively. Each of Claims 4 and 12 sets forth additional structural elements and novel steps of Applicant's novel assembly and method for preparing mailpieces.

It is further submitted that the question under 35 U.S.C. §103 is whether the totality of the art would collectively

suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements performed their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F. 2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's claimed invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of the *Walz* and *Petkovsek* patents in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to combine *Walz* with *Petkovsek* to produce the claimed invention. Therefore, *prima*